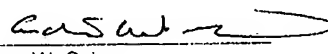


NOV 29 2010

## CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being submitted by First Class mail to the US Patent and Trademark Office: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 or transmitted by facsimile to the U.S. Patent and Trademark Office, Fax No. (571)283-8300.

Date: 11/29/10

By:   
Andrew W. SpicerMAIL STOP AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Michael A Plotnick et al.

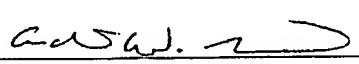
Conf. No.: 5480 : Group Art Unit: 2621  
Appln. No.: 10/006,874 : Examiner: NGUYEN, Huy Thanh  
Filing Date: 14 November 2001 : Attorney Docket No.: T738-10  
Title: Alternative Advertising in Prerecorded Media

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.
- ☒ Extension of Time to and including November 29, 2010 (November 27 being a Saturday) is filed herewith.

Date: 11/29/10

  
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**STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Claims 1-27, 29-34, 36-54, 57-59, 63-65, 110-113 and 118-121 are pending in the present Application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated May 27, 2010 ("May Office Action") and the Non-Final Office Action dated October 26, 2009 ("October Office Action"). Discussion of the prior art references and the pending claims may be found in Applicants' Request for Reconsideration filed January 27, 2010 ("January Response") and Amendment After Final Rejection filed October 27, 2010 ("October Response"), both of which are incorporated herein by reference. In view of the Advisory Action dated November 29, 2010 ("Advisory Action"), Applicants presume that the presently pending claims are those as submitted with the January Response.

***Procedural History***

The Examiner's rejection of the claims under 35 U.S.C. §103(a) over Unger in view of Slezak at pages 2 - 8 of the May Office Action and pages 2 - 11 of the October Office Action, merely *restates the same rejection, nearly verbatim*, as made in the Final Office Action dated September 25, 2007 ("Final Office Action") and the Non-Final Office Action dated February 26, 2007 ("Non-Final Office Action"). In response to the Final Office Action, Applicants filed a Notice of Appeal and a Request for Pre-Appeal Brief Conference with a Statement in support on December 17, 2007. In a decision dated January 28, 2008, the Pre-Appeal Brief Panel *withdrew the rejection* and reopened prosecution of the pending claims. Subsequently, a new non-final Office Action rejecting only claims 65-67 under 35 U.S.C. §102(e) was mailed on April 3, 2008. All other claims (1-27, 29-34, 36-54, 57-59, 63, 64, 110-113 and 118-121) were allowed. In an Amendment filed April 22, 2008, Applicants incorporated allowable subject matter into claim 65 and cancelled claims 66-68. Seventeen months passed before the Examiner issued the October Office Action (and only after repeated calls to the Examiner to ascertain the application status).

After receipt of the January Office Action, Applicants made repeated calls to Examiner Nguyen attempting to determine why the allowable subject matter was withdrawn and the

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exact same rejection was suddenly reinstated without explanation. The Examiner has been unable to provide any explanation regarding the rejection or the status of the application. Nonetheless, Applicants once again provided both written and oral arguments as to the impropriety of the rejection. Due to difficulties communicating with Examiner Nguyen, Applicants conducted a telephonic Interview with Examiner Tran on October 6, 2010. During the Interview, Examiner Tran suggested several claim amendments that would advance prosecution. Such suggestions were incorporated into the claims in the October Response filed October 27, 2010. The MPEP requires that, "[a]n amendment timely filed after a final rejection [be] immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An Examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days after the amendment is received by the Examiner." MPEP §714.13(III). However, Examiner Nguyen did not begin considering the October Response until November 24, 2010, only following repeated calls by Applicants' representatives to both Examiners Nguyen and Tran leading up to that date. Applicants have made a good faith effort to advance prosecution, but the lack of timely, coherent or consistent communication by the Office has added unreasonable delay and cost to Applicants in this matter.

The amendments of the October Response were made at the suggestion of Examiner Tran to advance prosecution. While Examiner Tran indicated that such amendments would be entered, Examiner Nguyen has refused to enter the amendments submitted with the October Response. Regardless, Applicants submit that such amendments were not necessary to overcome the cited prior art, but were made out of Applicants' desire to cooperate with Examiners Nguyen and Tran to bring the matter to resolution after inexplicable delays and repeated withdrawals of previously allowed subject matter. Thus, Applicants submit that the claims are patentable either with or without the amendments of the October Response.

#### *Insufficiency of Examiner's Office Actions*

The Examiner has not (in any of the Advisory Action, May Office Action or January Office Action) responded in any substantive or meaningful manner to Applicants' contentions regarding Examiner's errors in previous Office Actions. The Examiner continues to maintain

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rejections, without explanation, that are clearly not supported by the cited prior art. For example, claim 33 recites a "determination...that the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement," whereas claim 1 recites no such feature. Despite Applicants' previous remarks discussing such shortcomings, the Examiner continues to ignore Applicants' arguments and maintain unsubstantiated rejections. See January Response at pages 16-17 and October Response at pages 16-17.

*Alleged New Matter*

Applicants disagree with the Examiner's contention in the Advisory Action that amendments made in the October Response are new matter. To the extent that such arguments are made in any future Office Action, Applicants note that to satisfy the written description requirement under 35 U.S.C. § 112, first paragraph, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention (see MPEP § 2163(I)). This possession may be shown in any number of ways. For example, for newly added claim limitations, the MPEP requires that the specification provide support through express, implicit, or inherent disclosure (see MPEP § 2163(I)(B)).

Independent claim 1, as amended in the October Response, recites:

detecting an end of the trick play event...;

registering the detected end of the trick play event and continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement; and

returning to displaying a recorded programming at the end of the recorded advertisement.

Notwithstanding that the suggestion to add the "registering" language was made by Examiner Tran (a Supervisory Patent Examiner) and Applicants' position that no such amendment is necessary to render the claims patentable over the prior art, Applicants note that the features of the amended language were already implicit in the claim via the recitation, "continuing, until the end of the recorded advertisement...; and returning to displaying a recorded programming at the

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end of the recorded advertisement.” Specifically, in order to return to recorded programming after the end of the recorded ad, the command must be registered and executed at the end of the recorded ad. Thus, the original claims provide implicit and inherent disclosure for the registering feature of claim 1 (as amended). Furthermore, while the Application may not explicitly recite techniques for registering the detected end of the trick play event, those of ordinary skill in the art would understand that such a command may be registered by, for example, storing the command in cache or a register. Thus, the claims as amended in the October Response are in compliance with §112, first paragraph.

*No Prima Facie Obviousness*

1. Combination of Unger and Slezak does not teach each and every element of claim 1.

The Examiner argues that the alternative ad in claim 1 is “must view content”, such that in the proposed combination of Slezak and Unger, alternative ads would be played in their entirety as “must view content.” Page 20, May Office Action. However, Applicants have previously pointed out that in claim 1, the alternative ad is displayed only until the end of the recorded advertisement (not the end of the alternative ad) and is therefore not must view content. See October Response at pages 17-18.

Furthermore, in Slezak, must view content would **never** be switched to alternative content as in claim 1 because Slezak teaches that a **fast forward “process is waited,”** while Unger outputs tagged i-frames as static images **“until the fast forward operation is terminated.... The static image is replaced when normal playback is resumed upon termination of the fast forward operation.”** See October Response at pages 21-22.

2. Combination of Unger and Slezak does not teach each and every element of claim 33.

In addition to arguments presented with respect to claim 1, independent claim 33 further recites determining if “the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement.” None of Unger, Slezak, or the combination thereof teaches or suggests such determining. See October Response at page 23 and January Response at pages 16-17.

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3. Combination of Unger and Wang does not teach each and every element of claim 1.

The combination of Unger and Wang does not teach or suggest, “continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement,” as recited in claim 1. Applicants previously explained that Wang prevents **all skipping of advertisements**; thus, a trick-play could not be continued as asserted by the Examiner. See October Response at pages 26-27.

*The Proposed Combination is Improper*

1. Combination of Unger and Slezak uses impermissible hindsight.

The Examiner reads “alternative advertisements” as must-view content to support the proposed combination of Unger with Slezak. The problem with this interpretation, however, is that **neither Unger nor Slezak describes the alternative ads as being must-view**. In fact, because Slezak teaches that the original content is must view content, Slezak would not allow for the presentation of an alternative ad in the first place. Such teachings are only present in Applicants’ disclosure, and any attempted reading of such claimed subject matter on the prior art is impermissible hindsight. See October Response at pages 19-20 and MPEP § 2142.

2. Combination of Unger, Slezak and Wang frustrates purpose of Unger and is inoperable.

The Examiner does not address the fact that the combination of displaying tagged i-frames taught by Unger with Slezak’s ignorance of the **start of** trick-play events results in a bizarre situation where the alternative ads of Unger could never possibly be presented, because the teaching of Slezak would cause the trick play initiation command to be “waited” until the original ad has been displayed. Applicants have previously explained that removing alternative ads of Unger would frustrate the purpose thereof. See October Response at pages 20-21.

While Unger presents alternative advertisements to a user, Wang completely *prevents* the skipping of ads by disabling commands. There is no motivation to combine Unger and Wang in the way proposed by the Examiner because doing so would result in a system that is unsatisfactory for the intended purpose of presenting trick-play ads as described in Unger. See October Response at pages 25-26 and MPEP § 2143.01(V).